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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,898	08/07/2003	Chantal Amalric	03129CIP	7792

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EXAMINER	
LAMM, MARINA	

ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/635,898	AMALRIC ET AL.	
	Examiner	Art Unit	
	Marina Lamm	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgment is made of the amendment filed 11/30/04. Claims pending are 19-39. Claims 1-18 have been cancelled.

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 19-21, 24-26, 28, 29, 33 and 36-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Briggs et al. (WO 96/04894), of record.

Briggs et al. teach multiple cosmetic emulsions, containing an oily outer phase and two or more aqueous inner phases, wherein one of these aqueous phases can be in the form of a gel, containing gelling agent such as xanthan gum. See p. 7, second paragraph; p. 14, last paragraph; p. 15; Examples III and IV. The 1% aqueous solution of the gelling agent has a viscosity of at least about 4000 mPa.s. See p. 14. The emulsions of Briggs et al. contain emulsifiers such as dimethicone copolyol and/or laureth-7. See Examples; p. 16, second paragraph. The suitable outer phase oils of Briggs et al. include silicone oils, waxes, dicaprylate/dicaprate, isopropyl palmitate, etc and are present at the claimed concentrations. See p. 7; pp. 15-16; Examples. Briggs et al. teach preparing the emulsions by first preparing water and oil emulsion and then adding to the emulsions a gel phase. See Examples III and IV. The compositions of Briggs et al. may contain 1-12% of sunscreens, such as titanium dioxide, zinc oxide

and/or organic sunscreen. See pp. 12, 16; Example IV. The compositions of Briggs et al. also contain mineral fillers such as talc. See Example IV.

Thus, Briggs et al. teach each and every limitation of Claims 19-21, 24-26, 28, 29, 33 and 36-39.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 27, 30-32 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Briggs et al. (WO 96/04894).

Briggs et al. applied as above. With respect to Claim 27, the reference does not explicitly teach the claimed concentration of the gelling agent. However, the reference teaches that gelling agents can be present at a level preferably from about 0.01% to about 10%, more preferably from about 0.02% to about 2%, and especially from about 0.02% to about 0.5%. See p. 14, the last paragraph; p. 15, first two paragraphs. Further, Briggs et al. exemplifies 0.08% of xanthan gum. See Example IV. Therefore, the determination of optimal or workable concentration of the gelling agent by routine experimentation within the reference's generic disclosure is obvious absent showing of criticality of the claimed concentration. One having ordinary skill in the art would have been motivated to do this to obtain the desired stability of the formulation. With respect to Claims 30 and 31, the reference does not explicitly teach the claimed ratio of the primary emulsion to the aqueous gel. However, the determination of optimal or

workable ratio of the primary emulsion to the gel phase by routine experimentation is obvious absent showing of criticality of the claimed ratio. One having ordinary skill in the art would have been motivated to do this to obtain the desired moisturizing properties of the composition. With respect to Claim 32, the reference does not explicitly teach introducing the primary emulsion into the aqueous gel. However, there appears to be no criticality associated with the claimed order of mixing the ingredients because the prior art achieves the same results (i.e. preparing a dispersion in which the aqueous gel is dispersed in the water-in-oil emulsion) as claimed herein. Therefore, in the absence of some evidence of unexpected results due solely to the mixing ingredients in the specific order, it would have been obvious to one having ordinary skill in the art at the time of the invention to mix the primary emulsion and the gel in any order, because the prior art derives the same result as discussed above. With respect to Claims 34 and 35, Briggs et al. does not explicitly teach gelling an aqueous phase with a polymer and then mixing the aqueous gel with a primary w/o emulsion. However, Briggs et al. teach that their emulsions may contain a hydrophilic gelling agent in an aqueous solution. See p. 14, last paragraph. Further, Briggs et al. teach a mixture of propylene glycol and xanthan gum. See Example IV. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Briggs et al. such that to use water instead of or in addition to propylene glycol in Example IV. One having ordinary skill in the art would have been

motivated to do so because Briggs et al. teach gelling an aqueous solution with hydrophilic gelling agents as discussed above.

5. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Briggs et al. (WO 96/04894) in view of either Ansmann et al. (US 5,840,943) or Milius et al. (WO 00/56438 as translated by US 6,488,946), all of record.

Briggs et al. applied as above. The reference does not explicitly teach the claimed emulsifiers. However, Ansmann et al. teach making stable emulsions using polyglycerol polyhydroxystearate emulsifiers in combination with other conventional w/o emulsifiers, including polyglycosides. See Abstract; col. 5, lines 5-13, 66-67; col. 6, lines 1-2. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the emulsions of Briggs et al. such that to employ the emulsifiers of Ansmann et al. One having ordinary skill in the art would have been motivated to do this to obtain improved stability as suggested by Ansmann et al. The selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection. See e.g., *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Alternatively, Milius et al. teach using polyglycoside emulsifiers for making stable w/o emulsions. See Abstract. The emulsifiers of Milius et al. can be employed in combination with co-emulsifiers such as polyglycol polyhydroxystearates and silicone emulsifiers. See col. 4, lines 45-51. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the emulsions of Briggs et al. such

that to employ the emulsifiers of Milius et al. One having ordinary skill in the art would have been motivated to do this to obtain improved stability as suggested by Milius et al.

Response to Amendment and Arguments

6. The provisional obviousness-type double patenting rejection over claims 1-29 of copending Application No. 10/220,296 has been withdrawn in view of the amendment and arguments filed 11/30/04.

7. Applicant's arguments with respect to the Briggs et al. reference have been fully considered but they are not persuasive.

The Applicant argues:

> "It is not clear what the final structure of the compositions of Briggs et al will be, in particular how many aqueous phases will be present, and indeed the document is silent throughout concerning the actual number of aqueous phases. While it is possible that the xanthan gum added in step (d) combines with both aqueous phases present at the end of step c), Applicants submit that it is more likely that the xanthan gum mixture forms a new, third inner phase, given that the emulsion contains a coalescence inhibitor, intended to prevent coalescence of the aqueous phases. While Phase L does not contain water, it is hydrophilic, and would be expected to remain distinct in the oleophilic outer phase." See pp. 7-8 of the reply.

In response, it is noted that that Briggs et al. teach "two or more aqueous phases". See Abstract. On pp. 5 and 7, the reference teaches a multiple phase w/o emulsion containing two discrete internal aqueous phases. With respect to xanthan gum, since phase L (xanthan gum and propylene glycol) is added together with phase K (deionized water) in Example IV, it is reasonable to conclude that the both phases will mix and form an aqueous gel. Since the Office does not have the facilities for examining

and comparing applicants' product with the product of the prior art, the burden is on applicant to show novel and unobvious differences between the claimed product and the product of the prior art (i.e., that the multiple emulsion of the prior art does not possess the same material and functional characteristics of the claimed emulsion).

Further, the Applicant argues:

> "In any event, given that the xanthan gum is mixed with propylene glycol and not with water, it does not seem that this mixture may fairly be described as an "aqueous gel," this term normally referring to a structured polymer swollen with water (and not an alcohol) as solvent. It may be noted that on page 22, Briggs et al add that "[F]inally phases K, L, M and N are added as diluent." The fact that the word "diluent" is used *further implies that this latter mixture is a low-to-moderate viscosity fluid, not a gel.*" (emphasis in original). See p. 8 of the reply.

In response, Briggs et al. explicitly teach that the 1% aqueous solution of the hydrophilic gelling agent has a viscosity of at least about 4000 mPa.s, more preferably at least about 10,000 mPa.s and especially at least 50,000 mPa.s. See p. 14, last paragraph. Further, it is noted that Example III contains aloe vera gel in phase N, which meets the limitation "aqueous gel".

Further, the Applicant argues:

> "both current claims 19 and 29 require the presence of an emulsifier, and while Briggs et al does mention emulsifiers on page 16, there is no example of their use (specifically, no emulsifier is present in Examples III and IV). Instead, Briggs use coalescence inhibitors (specifically, electrolytes such as sodium chloride), which stabilize emulsions formed not using amphiphilic surfactants, but instead agents such as wax." See p. 8 of the reply.

In response, the composition IV of Briggs et al. contains conventional emulsifiers such as dimethicone copolyol and laureth-7. See p. 18.

In response to Applicant's argument that there is no suggestion to combine the Briggs et al. and either Milius et al. or Ansmann et al. references (see p. 10 of the reply), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Ansmann et al. and Milius et al. teach using the claimed emulsifiers for the preparation of cosmetic w/o emulsions having improved stability. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the emulsions of Briggs et al. such that to employ the emulsifiers of Milius et al. or Ansmann et al. One having ordinary skill in the art would have been motivated to do this to obtain improved stability as suggested by Milius et al. or Ansmann et al.

Finally, the Applicant argues that Briggs et al. generally teach against the use of emulsifiers". See p. 10. In response it is noted that the exemplifies compositions of Briggs et al. contain conventional emulsifiers such as dimethicone copolyol and laureth-7, as discussed above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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3/29/05